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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Kernel Creations, Ltd.

Serial No. 75/087,988

Robert M. Mason of Mason and Petruzzi for Kernel Creations, Ltd.

Jennifer M. Martin, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).

Before Hairston, Walters and Rogers, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Kernel Creations, Ltd. has filed an application to register on the Principal Register the mark PATENT PENDING for "computer programs to aid inventor(s) in disclosing an invention and instruction manuals sold therewith."[1]

[1] Serial No. 75/087,988, in International Class 9, filed April 15, 1996, based on an allegation of a bona fide intention to use the mark in commerce.

The Trademark Examining Attorney issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its goods.

Applicant filed its notice of appeal and both applicant and the Examining Attorney filed briefs. In her brief, the Examining Attorney referred, for the first time, to various provisions of the patent laws, in particular, 35 U.S.C. §292, which specifically prohibits false use of the "patent pending" legend for the purpose of deceiving the public. In view of this statutory provision, the Board suspended the appeal and remanded the application to the Examining Attorney to consider whether additional grounds for refusal may be present, including "whether applicant's asserted mark is or may be lawfully used in commerce or, because the use of this term is restricted by law, whether or not the proposed mark is or can function as a trademark identifying and distinguishing applicant's goods."

The Examining Attorney maintained the refusal on the ground that the proposed mark is merely descriptive and also issued a refusal, under Sections 1 and 45 of the Trademark Act, 15 U.S.C. §§1051 and 1127, on the ground that applicant's use of its proposed mark "would be unlawful under 35 U.S.C. §292 because it would be a false use of the

'patent pending' legend." In the Office action of February 28, 2001, the Examining Attorney stated the following:

> The term "patent pending" is protected by statute [35 U.S.C. §292] and is used to identify the fact that a patent application is pending with claims that cover the marketed product. The term cannot be used to identify and distinguish the applicant's goods from those of others nor can the applicant claim that it is the owner of the statutorily protected term.

Ultimately, both grounds for refusal were made final and this appeal resumed. Both applicant and the Examining Attorney filed supplemental briefs, but an oral hearing was not requested.

Use as a Trademark

The statutory provision of Title 35 reads as follows:

§292. False Marking

(a) …

> Whoever marks upon, or affixes to, or uses in advertising in connection with any unpatented article, the word "patent applied for," "patent pending," or any word importing that an application for patent has been made, when no application for patent has been made, or if made, is not pending, for the purpose of deceiving the public –
>
> Shall be fined not more than $500 for every such offense.

The Examining Attorney argues as follows:

> [T]he statutes themselves do not provide the basis for refusal of trademark registration and thus the applicant's mark was not refused under 35 U.S.C. §292. In determining whether registration should be refused in a particular application, the relevant statute should be consulted to determine the function of the designation and its

> appropriate use. TMEP 1205.01. In this case the purpose of the designation "patent pending" as proscribed (sic) by 35 U.S.C. §292 is to notify the public that a patent is pending with regard to the identified articles.
>
> The proposed mark is protected by statute with the purpose of notifying the public that a patent is pending. If the applicant were using the mark in a lawful manner, namely to indicate that a patent has been applied for, such lawful use would not also act [as] a source indicator. The proposed mark, if used lawfully, is incapable of functioning as a trademark to identify and distinguish applicant's goods, because the purpose of lawful use of the term is to notify the public that a patent is pending with regard to the identified goods.

Applicant contends that its proposed use of the term "patent pending" is not in violation of 35 U.S.C. §292; that the Examining Attorney has not established that a patent application for the product is not pending or that applicant's proposed use is intended to deceive the public; that "it does not require undue imagination to conceive of situations in which the use of the term 'Patent Pending' could be used in connection with a product or service for which a patent is not pending, but is not used for the purpose of deceiving the public"; and, alternatively, that "if the term 'Patent Pending' were used in connection with the product in such a way as to create in the minds of the public that the term is used to help an inventor disclose an invention, rather than [to indicate] a patent application pending in connection with the product, no statutory violation would be present." (Applicant's brief, pg. 2.)

Applicant argues that use alone of the term is not a violation of the statute and states that "[u]nlike other terms such as 'FBI' or 'Olympic' which in the proper case one might be able to draw a conclusion of sponsorship or endorsement merely from the proposed application, one cannot automatically conclude that the use of patent pending is 'deceiving' without knowing the actual use."

The Examining Attorney's refusal to register under Sections 1 and 45 of the Trademark Act encompasses two different inquiries with respect to use. The first question is whether the proposed use in commerce is lawful. The Board has articulated the standard for holding use of a mark to be unlawful as requiring either (1) a finding by a court or appropriate governmental agency of noncompliance with a law or (2) a clear per se violation. *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d (TTAB 1988). Further, proof of the noncompliance or per se violation must be established by clear and convincing evidence. *General Mills, Inc. v. Health Valley Foods*, 24 USPQ 1270 (TTAB 1992). See *McCarthy on Trademarks and Unfair Competition,* J. Thomas McCarthy (4th ed. 2003). This application is based on applicant's allegation of a bona fide intention to use its mark in connection with the identified goods and the record contains no evidence of use. Clearly, there is no

basis for the Board to affirm the refusal based on unlawful use of the mark by applicant.[2]

Our second inquiry regarding use, or more accurately in this case, intended use, is not whether applicant has violated the provisions of the cited criminal statutory provision.[3] Rather, we must determine whether, in view of the nature and import of the term, as evidenced by the statutory provision and the goods identified in the application, PATENT PENDING can function as a trademark to identify the source of the goods. Both the terms "patent pending" and "disclosure" are legal terms of art in the patent field. We note the definitions submitted by the Examining Attorney:

> *Disclosure* – Act of disclosing. Revelation; the impartation of that which is secret or not fully understood. In patent law, the specification; the statement of the subject matter of the invention, or the manner in which it operates. *Black's Law Dictionary*, 5th ed.

[2] The Examining Attorney may reconsider this refusal should applicant file evidence of use that supports such a refusal. However, the viability of such a refusal is clearly fact specific, and establishing intent to deceive may be beyond the capability of an ex parte proceeding.

[3] Applicant is quick to point out that the record contains no information as to whether or not applicant has filed a patent application for the identified goods. While we do not need to know this fact to determine the trademark issues involved herein, we find applicant's game playing disagreeable. If applicant believes the statutory prohibition against deceptive use of the phrase is irrelevant because it actually has a "patent pending," then it should simply have said so. On the other hand, if it does not have a patent pending but believes that the statutory provision is inapplicable because its planned method of use cannot possibly be such as to deceive the public, then, likewise, it should simply have said so.

> *Patent Pending* – A phrase often marked on products, indicating that a patent application is pending with claims that cover the marked product. Statutory Reference – 35 U.S.C. §292(a), 3rd paragraph. *McCarthy's Desk Encyclopedia of Intellectual Property*, J. Thomas McCarthy (2nd ed. 1990).

Applicant's proposed goods, as identified, will consist of software that permits an inventor or his or her agent to specify the subject matter and/or manner of operation of his or her invention, for, as applicant's identification notes, the purpose of disclosing such specifications. It is reasonable to assume that the purpose of such an exercise is to complete and file at the USPTO an application to obtain a patent; at least, it is reasonable to assume an inventor would not utilize the product to disclose an invention merely as an altruistic act. Thus, the proposed goods are directly related to the filing of a patent application. Use of the term "patent pending" in connection with these goods is likely to be perceived as the legal term defined above, not as a trademark identifying applicant's goods.

Additionally, we believe that prospective patent applicants will be aware of the existence of the USPTO Internet web site that permits public access to various collections of public information as well as a means for communicating with the USPTO. It is reasonable to conclude that prospective purchasers of applicant's software are not likely to perceive of the term "patent pending" in

connection with applicant's goods as identifying source. It is more likely that such purchasers will see the term as indicating that the software is the product of an affiliation with the USPTO, or is an authorized means of making disclosures of inventions to the USPTO, because it is the government agency that issues patents.

Therefore, we affirm the refusal under Sections 1 and 45 of the Trademark Act on the ground that the subject matter of the application cannot function as a trademark in connection with the identified goods. We do not affirm this refusal based on the asserted ground that applicant's proposed use is not lawful use in commerce.

Mere Descriptiveness

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well-

established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

As previously stated, the purpose of applicant's product is to enable an inventor or his or her agent to disclose the invention for purposes of filing a patent application. Clearly the term PATENT in the proposed mark is merely descriptive in connection therewith. However, it is necessary to look at the mark as a whole, particularly relevant in this case, because the phrase PATENT PENDING has a very specific legal significance with respect to the patent system, as noted above. The acceptance of a patent application and the ability to legally use the phrase PATENT PENDING in connection with an invention is the goal of the person using applicant's proposed software. Thus, the proposed mark describes the hoped-for end result of the use of the software.

When applied to applicant's goods, the term PATENT PENDING immediately describes, without need for conjecture or speculation, a significant feature or function of applicant's goods, namely the purpose of the software, which

is to enable an inventor or his or her agent to disclose the invention for the purpose of obtaining a patent. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's product to readily perceive the merely descriptive significance of the term PATENT PENDING as it pertains to applicant's goods. The prospective purchaser or user of the software will immediately perceive that its use will facilitate the user having a "patent pending" before the USPTO.

Decision: The refusal under Sections 1 and 45 of the Trademark Act, on the ground that the subject matter of the application cannot function as a trademark in connection with the identified goods, is affirmed. The refusal under Section 2(e)(1) of the Act, on the ground that the proposed mark is merely descriptive, is affirmed.